

## REMARKS

Following entry of the above amendments claims 3 and 5-8 are pending. Claims 1, 2, 4, and 9-44 have been cancelled. Claims 3 and 5 have been amended to focus on particular embodiments of the instant invention. Support for the amendments is found in the specification as originally filed. See, for example, page 25 line 11 through page 26 line 6; page 27, lines 4-22; page 27 line 27 through page 28 lines 1-2 and 7-9; page 29 line 3 through page 30 line 9; pages 67-181 and the examples therein; and the claims as originally filed.

The Office Action states the title of the invention is not descriptive and requires a new title. Applicants have provided a new title that Applicants believe is clearly indicative of the invention to which the claims are directed.

### ***Rejection under 35 USC §112 – First Paragraph***

The Office Action states claims 9-14, 22-42, and 44 are rejected for not reasonably providing enablement for all cancers. Applicants do not agree with the Examiner's rejection. However, to further prosecution, Applicants cancel claims 9-14, 22-42, and 44 and expressly reserve the right to file divisional applications or take such other measures deemed necessary to protect the inventions in the cancelled claims. The rejection is now moot and Applicants respectfully request withdrawal of the rejection.

### ***Rejection under 35 USC §102(a) and §102(e) – Anticipation***

The Office Action states that claims 1-3, and 6-8 are rejected under §102(a) and §102(e) as being anticipated by Liu et al. Applicants cancel claims 1, 2 and 4, and amend claim 3, to overcome the rejection. Claims 6-8 depend from amended claim 3. The rejection is now moot and Applicants respectfully request withdrawal of the rejection.

***Rejection under 35 USC §103(a) – Obviousness***

The Office Action states claims 1-8 are rejected under §103(a) as being unpatentable over **Liu et al.** Applicants respectfully traverse this rejection.

As stated in MPEP §2142 and §2143, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To do so, the Examiner must ascertain the differences between the prior art and the claims in issue, and must demonstrate some suggestion or motivation, in the references themselves or in the knowledge generally available to those skilled in the art, to modify the prior art to arrive at the present invention. Furthermore, the Examiner must avoid impermissible hindsight, and must reach a conclusion of obviousness based on the facts gleaned from the prior art.

The Examiner states that **Liu, et al.** do not teach specifically all of the compounds which fall into the scope of the instant invention. However, the Examiner concludes that **Liu, et al.** teach “generally the compounds of the instant invention where R<sup>11</sup> is H, D is phenyl optionally substituted as defined and all other substitutions are as defined, [thus] it would have been obvious to one of ordinary skill in the art at the time of the claimed invention was made [sic] to follow the synthetic scheme of **Liu, et al.** and make the claimed invention with a reasonable expectation of success.” The Examiner further states that the motivation provided by **Liu, et al.** is the use of the synthesized compounds to treat inflammatory bowel disease.

To determine whether a *prima facie* case of obviousness exists, MPEP §2144 *et seq.* requires the Examiner to ascertain the differences between the prior art and the claims in issue. To ascertain the differences in a genus-species chemical composition situation, MPEP 2144.08(II)(A)(2) provides that the closest disclosed species or subgenus in the prior art reference should be identified and compared to that claimed, and specific findings on the similarities and differences between the prior art and instant invention relating to similarity of structure, chemical properties, and utilities, should be made. The Examiner states that **Liu, et al.** teach “generally the compounds of the instant invention where R<sup>11</sup> is H, D

is phenyl optionally substituted as defined and all other substitutions are as defined.” Such statement does not constitute specific findings on the similarities and differences between the prior art and instant invention relating to similarity of structure, chemical properties, and utilities as required by MPEP §2144.08(II)(A)(2). Since the Examiner has failed to properly ascertain the differences between the prior art and the claims in issue by making specific findings of fact, the Examiner has not factually supported his *prima facie* conclusion of obviousness as required by MPEP §2142. Therefore, Applicants respectfully request withdrawal of the rejection.

In addition, to render the instant invention obvious, the Examiner must demonstrate some suggestion or motivation in the reference itself to arrive at the present invention. The Examiner states that it would have been obvious for one skilled in the art to follow the synthetic scheme of **Liu** to make the claimed invention. However, the Examiner does not demonstrate where in the **Liu** reference the motivation or suggestion exists to make the specific modifications of the compounds in **Liu** to arrive at the instant invention. The fact that the **Liu** reference teaches compounds that are believed to be useful for treating inflammatory bowel disease is irrelevant. The court in *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) provides “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” The **Liu** reference does not provide the skilled artisan either the necessary teachings to combine, or the motivation to select, the elements required to arrive at the instant invention. In fact, **Liu** does not even suggest making any compounds other than those specifically exemplified in the reference. Thus, the Examiner’s rejection is nothing more than improper hindsight construction of Applicants’ claimed invention. Therefore, the Examiner fails to present a *prima facie* case of obviousness, and Applicants respectfully request withdrawal of the obviousness rejection.

***Rejection under nonstatutory double patenting – Obviousness-type***

The Office Action states that claims 1-8 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 19, and 21 of U.S. Patent No. 6,399,773. Applicants respectfully submit that U.S. Patent No. 6,399,773 and the instant application are not commonly owned, thus obviousness-type double patenting cannot apply. Applicants respectfully request withdrawal of the rejection.

The points and concerns of the Examiner have been addressed in full. Applicants respectfully submit that the instant application is in condition for allowance, which action is respectfully requested. Should any issues remain unresolved in this application which would bar issuance, the Examiner is invited to contact the undersigned Attorney at (919) 483-6334 to discuss such issues.

Applicants believe that no fees are due in connection with the filing of this paper other than those specifically authorized herewith. However, should any other fees be deemed necessary to effect the timely filing of this paper the Commissioner is hereby authorized to charge such fees to Deposit Account No. 07-1392.

Respectfully submitted,



Jennifer L. Fox  
Attorney for Applicants  
Registration No. 52,218

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GlaxoSmithKline

Five Moore Drive, PO Box 13398  
Research Triangle Park  
North Carolina 27709  
(919) 483-6334